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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,303	01/31/2001	Larry M. Proctor	414634	8508

7590
Larry M. Proctor
2611 State Highway 348
Delta, CO 81416

07/08/2010

EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
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1638

MAIL DATE	DELIVERY MODE
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07/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,892	12/20/2000	5894079	396168	6243

7590 07/07/2010
Larry M. Proctor
2611 State Highway 348
Delta, CO 81416

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/07/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LAW OFFICES OF DODDS & ASSOCIATES
1707 N ST., NW
WASHINGTON, DC 20036

Date: **MAILED**

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005892
PATENT NO. : 5894079
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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JUL 07 2010

Larry M. Proctor
2611 State Highway 348
Delta, Colorado 81416

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

Law Offices of
Dodds & Associates
1707 N St., NW
Washington, DC 20036

(For Third Party Requester)

In re reissue application of
Larry M. Proctor
Application No. 09/773,303
Filed: January 31, 2001
For: U.S. Patent No. 5,894,079

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:
: **DECISION, SUA SPONTE,**
: **TO SEVER**
: **REEXAMINATION AND**
: **REISSUE PROCEEDINGS**

In Larry M. Proctor
Reexamination Proceeding
Control No. 90/005,892
Filed: December 20, 2000
For: US. Patent No. 5,894,079

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The merged proceeding consisting of reissue application 09/773,303 and *ex parte* reexamination proceeding 90/005,892 is before the Office of Patent Legal Administration (OPLA) for consideration of whether the merger should be dissolved so that the reissue application and the reexamination proceeding can separately proceed.

BACKGROUND

1. Patent number 5,894,079 issued on April 13, 1999.
2. On December 20, 2000, a request for reexamination of claims 1-15, all of the claims in the '079 patent, was filed by a third party requester, and was accorded control number 90/005,892 (the '5892 proceeding).

3. On January 31, 2001, patent owner filed a reissue application, which was accorded application number 09/773,303 (the '303 reissue), requesting correction of errors in U.S. Patent number 5,894,079, and including claim amendments and new claims 16-58.
4. On February 6, 2001, reexamination of claims 1-15 was ordered in the '5892 proceeding.
5. On June 13, 2001, the Office issued a decision merging the above identified reissue application and reexamination proceeding.
6. On April 29, 2008, the Board of Appeals and Interferences affirmed the examiner's final rejection of claims 1-15, 51, 52, and 56-64, all of the claims pending and not withdrawn from consideration in the case.
7. On September 23, 2009, the Court of Appeals for the Federal Circuit (the Federal Circuit) issued a mandate affirming a finding of unpatentability for all of the claims at issue in the merged '079 patent proceeding of the '079 patent as being obvious, in violation of 35 U.S.C. § 103. *In re Pod-Ners*, 93 U.S.P.Q.2d 1411 (Fed. Cir. 2009).

RELEVANT LAW AND PROCEDURE

MPEP § 1216.01 provides:

In an *ex parte* appeal, after the [Federal Circuit] mandate is issued, the application or reexamination file is then returned to the appropriate U.S. Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.

A. All Claims Rejected

If all claims in the case stand rejected, proceedings in the case are considered terminated on the issue date of the Federal Circuit's mandate. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. *Continental Can Company v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). [Emphasis added]

MPEP § 1214.06 provides:

I. NO CLAIMS STAND ALLOWED

The proceedings in an application or *ex parte* reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. **In an *ex parte* reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570.** [Emphasis added]

DECISION

The Office is acting, *sua sponte*, to determine the propriety of maintaining the merger of the proceedings in view of the September 23, 2009 Federal Circuit holding of unpatentability for all of the appealed claims in the '5892 reexamination and '303 reissue of the '079 patent. MPEP § 2286 states that reexamination will continue if there exists any original, new, or amended claim being examined that was not found invalid or unenforceable by the court so long as a substantial new question of patentability (SNQ) exists for that claim. The '5892 reexamination, subsequent to merger with the '303 reissue, contained patent claims 1-15 and new claims 16-61, of which only claims 1-15, 51, 52, and 56-64 were appealed.¹ As of September 23, 2010, the issue date of the Federal Circuit's mandate, the case is no longer pending and the proceedings in this case are considered terminated. When no claims stand allowed following the mandate of the Federal Circuit, prosecution of the reexamination is to be terminated pursuant to § 1214.06, and a reexamination certificate should be issued.

After consideration of the record of the merged application/proceeding, it is decided that the merger of the two proceedings is no longer the appropriate option for this fact situation. The Office's June 13, 2001 merger of the reissue application and reexamination proceeding is hereby severed, and the guidance set forth in the merger decision is no longer applicable to the now-separate reissue application and reexamination proceeding.

Further Treatment of Severed Proceedings

1. *Ex Parte* Reexamination Proceeding 90/005,892

No claims stand allowed in the reexamination proceeding. When following the mandate of the Federal Circuit no claims stand allowed, pursuant to MPEP §1214.06, prosecution of the reexamination is to be terminated, and a reexamination certificate should be issued. Therefore, the '5892 *ex parte* reexamination proceeding is being forwarded to the CRU to issue a Notice of Intent to Issue a Reexamination Certificate (NIRC), with the proceeding to be concluded in due course by issuance of a reexamination certificate.

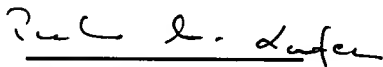
2. Reissue Application 09/773,033

In view of the Federal Circuit decision of unpatentability for all of the claims appealed in the merged '5892 reexamination and '303 reissue proceeding of the '079 patent, the '033 reissue application is being forwarded to Technology Center 1600 for further handling consistent with the decision and in accordance with reissue practice and the guidance in MPEP §§ 1216.01 and 1214.06. As of September 23, 2010, the issue date of the Federal Circuit's mandate, the case is no longer pending and the proceedings in this case are considered terminated.

¹ Claims 54 and 55 have been cancelled. Claims 16-50, 53, and 65-71 were withdrawn from consideration.

CONCLUSION

1. The merger of the '5892 reexamination proceeding and the '303 reissue application is hereby severed.
2. Jurisdiction over the '5892 reexamination is forwarded to the CRU for further processing in view of the Federal Circuit decision of unpatentability for all of the claims at issue in the merged '5892 reexamination. *In re Pod-Ners*, 93 U.S.P.Q.2D (BNA) 1411 (Fed. Cir. 2009). Specifically, the CRU shall issue a NIRC directing cancellation of all claims in the proceeding, with the proceeding to be concluded in due course by issuance of a reexamination certificate cancelling claims 1-15 of the '079 patent.
3. Jurisdiction over the '303 reissue application is being returned to Technology Center 1600 for further processing in accordance with reissue practice in view of the finding of unpatentability for all of the claims at issue in the '303 reissue proceeding. *In re Pod-Ners*, 93 U.S.P.Q.2d 1411 (Fed. Cir. 2009).
4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer (571) 272-7726.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

July 7, 2010